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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,265	04/03/2006	Nicolas Droger	ESSR:112US/10604356	6405
33425 7590 05/21/2008 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701				
EXAMINER				
NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
05/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,265

Applicant(s)

DROGER ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39 and 41-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 52-57, 59-61 and 76-82 is/are allowed.
- 6) ☒ Claim(s) 39, 47-51, 58, 62, 63 and 73-75 is/are rejected.
- 7) ☒ Claim(s) 41-46 and 64-72 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/17/08 and 2/19/08 have been entered.

The amendment of 3/17/08 and 2/19/08 have been entered. Claims 39 and 41-82 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 39, 47-51, 58, 62-63, and 73-75 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5525654 Podola et al..

Podola et al. discloses a thermoset plastic material comprising a three dimensional matrix containing sulfur atoms, after their sealant cures, and containing a diurethane which falls within the scope of the instantly claimed antiplasticizers of the instant claims. The reaction of the mercaptoalkyl alkoxysilanes, of column 4, lines 30-59 and column 5, lines 1-3, particularly

noting “preferably”, with the disclosed NCO groups makes the instantly claimed thiourethane groups resulting in polythiourethanes. The plasticizers of the patentee, column 5, line 42-67; column 6, lines 1-22; column 7, lines 1-9; column 8, lines 11-35; column 9, lines 36-37, which fall within the scope of the carbonyl containing compound of claim 51. The patentee is silent regarding the parameters of the instant claims 47-50. The PTO has no facilities to make experimental determinations. The burden is therefore on the patentee to show that the compositions discussed above do not necessarily inherently have the properties of the instant claims 47-50 and 73-75 because the components of the cured product of the patentee are otherwise those of the instant claims and would therefore be expected to necessarily and inherently possess the instantly claimed parameters of the instant claims 47-50 and 73-75. See MPEP 2112. Column 6, lines 22-29 falls within the scope of the instant claim 62-63. See the abstract; column 2, lines 28 to column 14, line 56, particularly those sections discussed above.

5. Claims 39, 47-51, 58, 62-63, and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5525654 Podola et al..

Podola et al. discloses a thermoset plastic material comprising a three dimensional matrix containing sulfur atoms, after their sealant cures, and containing a diurethane which falls within the scope of the instantly claimed antiplasticizers of the instant claims. The reaction of the mercaptoalkyl alkoxysilanes, of column 4, lines 30-59 and column 5, lines 1-3, particularly noting “preferably”, with the disclosed NCO groups makes the instantly claimed thiourethane groups resulting in polythiourethanes. The plasticizers of the patentee, column 5, line 42-67; column 6, lines 1-22; column 7, lines 1-9; column 8, lines 11-35; column 9, lines 36-37, which fall within the scope of the carbonyl containing compound of claim 51. The patentee is silent

regarding the parameters of the instant claims 47-50. The PTO has no facilities to make experimental determinations. The burden is therefore on the patentee to show that the compositions discussed above do not necessarily inherently have the properties of the instant claims 47-50 and 73-75 because the components of the cured product of the patentee are otherwise those of the instant claims and would therefore be expected to necessarily and inherently possess the instantly claimed parameters of the instant claims 47-50 and 73-75. See MPEP 2112. Column 6, lines 22-29 falls within the scope of the instant claim 62-63. See the abstract; column 2, lines 28 to column 14, line 56, particularly those sections discussed above.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use those combinations of ingredients and amounts thereof disclosed by the patentee that fall within the scope of the instant claims because they are disclosed by the patentee and would have been expected to give the matrices having the properties of those of the patentee.

6. Claims 41-46 and 64-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The inventions of these claims are not disclosed in the prior art considered and the prior art considered does not provide motivation to modify their teachings into the instantly claimed inventions.

7. Claims 52-57, 59-61, and 76-82 are allowable over the prior art considered. The inventions of these claims are not disclosed in the prior art considered and the prior art considered does not provide motivation to modify their teachings into the instantly claimed inventions.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796

